

REMARKS

Claims 2 and 15 have been amended herein. Claims 28-35 have been added. Claims 1-35 are now pending in the Application. No new matter has been added. Claim 2 has been amended to clarify that step (d) includes sending data corresponding to the at least one identification value and the at least one financial account to the remote host system. Claim 15 has been amended to correct a typographical error. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Amendments to Drawings/Specification

In the Action, the Specification was objected to for informalities related to reference numbers. Applicants have amended the Specification at the page 10, line 1 to replace "the wireless ATM server 38" with --the wireless ATM server 40-- as suggested in the Action. In addition, Applicants have amended the Specification at the page 14, line 12, to replace "ATM 128" with --ATM 122-- as suggested in the Action. Further Applicants have amended the Specification at the paragraph beginning on page 14, line 19, to clarify that the reference number "138" of Figure 5 corresponds to the "a first portable wireless device" and the reference number "136" of Figure 5 corresponds to "a second portable wireless device." No new matter has been added. It is respectfully submitted that these amendments obviate the objection.

The Pending Claims Are Not Anticipated or Obvious in View of the Applied Art

Claims 1, 2, 4, 5, 8, 9 and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Gutman, et al., U.S. Patent No. 5,221,838 ("Gutman").

Claims 16 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Waller, et al., U.S. Patent Application Publication No. 2001/0051922 A1 (“Waller”).

Claims 3, 6-7, 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gutman in view of Waller.

Claims 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waller in view of Gutman.

Claims 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waller alone.

These rejections are respectfully traversed.

Waller Reference Is Not Prior Art under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a)

As indicated on page 1 of the Specification and on the Official Filing Receipt, the present application is entitled to (and claims the benefit of) the October 4, 2000 filing date of provisional application serial No. 60/237,812. The filing date for this provisional application is earlier than the February 9, 2001 U.S. filing date of Waller. Thus Waller cannot constitute prior art with respect to the present invention pursuant to 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) . It follows that the rejections of claims 3, 6-7, 10-14, 16-27 based fully or in part on Waller are not valid and should be withdrawn.

In addition, Applicants request acknowledgment of their claim for domestic priority to U.S. Provisional Application Serial No. 60/237,812 filed October 4, 2000.

Brief Description of the Invention

The present invention is directed to an apparatus and method. In an exemplary embodiment the apparatus comprises an automated banking machine including a computer. The apparatus further includes at least one transaction function device such as a cash dispenser in the automated banking machine, that is in operative connection with the computer. In addition, the apparatus may comprise a wireless access hub in operative connection with the computer. The wireless access hub enables the automated banking machine to communicate with a plurality of portable wireless devices. The computer is operative to enable the plurality of portable wireless devices to carry out a plurality of transactions with the automated banking machine. When at least two of the portable wireless devices initiate transactions that require the operation of one transaction function device, the computer is operative to cause outputs to be generated from at least one output device to sequentially prompt users of the at least two portable wireless devices initiating the transactions to move adjacent the one transaction function device; for example, to receive dispensed cash the value of which has been assessed to the account of the particular user.

The Applied References Do Not Disclose or Suggest the Features and Relationships Recited in Applicants' Claims

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would

literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Gutman Reference

Gutman is directed to an electronic wallet (100) which is capable of wireless or wired communication with a central financial institution computer (Column 8, lines 59-60). An example of a transaction that may be performed with the electronic wallet includes a "cash transaction." A cash transaction as defined in Gutman corresponds to the electronic wallet 502 (Figure 5A) communicating with a financial institution 500 to modify an amount in an account balance such as by transferring cash from one account balance to another account balance or initiating a transaction to transfer cash from a borrowing account balance to a cash account balance (Column 13, lines 10-18; Column 14, lines 34-37). The only place Gutman mentions Automated Teller Machines (ATMs) is in the Background Of The Invention section of the patent (Column 1, lines 31, 47, 49). Here Gutman refers to ATMs as dedicated terminal devices connected to a central financial computer. Gutman does not disclose or suggest that central financial computers are ATMs. Although Gutman discloses communication between a financial institution and an electronic wallet, nowhere in Gutman is it disclosed or suggested that the electronic wallet communicate with an automated banking machine such as an ATM.

The Features Recited in Applicants' Claims Patentably Distinguish Over Gutman

In the Action claims 1, 2, 4, 5, 8, 9, and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Gutman. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretation of Gutman. Thus, any change in the Office's interpretation of Gutman shall constitute a new ground of rejection.

Claim 1

Claim 1 is an independent claim directed to a method. The method comprises: (a) receiving with an automated banking machine a wireless message representative of a request to establish a wireless connection with a portable wireless device; (b) establishing the wireless connection between the banking machine and the portable wireless device; (c) receiving through the wireless connection a second message from the portable wireless device representative of a request to perform a transaction with the banking machine; (d) authorizing the transaction through communication between the banking machine and a remote host system; (e) sending from the banking machine through the wireless connection to the portable wireless device an authorization confirmation message; (f) receiving through the wireless connection from the portable wireless device a commit transaction message; and (g) completing the authorized transaction through operation of the banking machine.

The Action alleges that Gutman teaches these steps. Applicants disagree. Gutman does not disclose or suggest wireless connections between a portable wireless device and an automated banking machine. Rather, Gutman is directed to an electronic wallet (100) which is capable of wireless or wired communication with a central financial institution computer (Column 8, lines 59-60).

Applicants' Specification on page 1, lines 9-10 indicates that an automated teller machine ("ATM") is a type of automated banking machine. Neither Applicants' Specification nor Gutman discloses or suggests that a central financial institution computer corresponds to an automated banking machine or ATM. Rather the Background Of The Invention section of Gutman teaches that an ATM is a dedicated terminal device (Column 1, lines 30-31). Although Gutman teaches

that an ATM may be connected to a central financial computer, nowhere does Gutman disclose or suggest that an ATM or automated banking machine is a central financial computer.

Further, claim 1 specifically recites steps involving three different components: 1) an automated banking machine, 2) a portable wireless device; 3) and a remote host system. The Action appears to assert that the portable wireless device recited in claim 1 corresponds to the electronic wallet of Gutman. The Action further appears to assert that the automated banking machine recited in claim 1 corresponds to the central financial institution computer. In addition the Action appears to allege that the remote host system corresponds to the third party (524) shown in Figures 5C-5E and discussed at Column 14, lines 17-67 of Gutman.

Applicants respectfully submit that none of the examples shown in Gutman involving an electronic wallet, central financial institution computer, or third party discloses or suggests the specific steps recited in claim 1 involving a portable wireless device, an automated banking machine, and a remote host system.

For example, in Figures 5C-5E, Gutman states that his electronic wallet (52) initiates a transaction with a financial institution (522) and a third party (524) by sending a message to the financial institution (522) via the third party (524). The third party then handshakes the information with the financial institution (522). The electronic wallet (520) then receives a confirmation message from the financial institution (522).

Even if it were possible for Gutman's central financial institution computer to correspond to an automated banking machine, which it does not, the communications disclosed in Gutman between the electronic wallet, financial institution, and third party are the opposite of the communications recited in claim 1.

For example, step (c) of claim 1 recites receiving through the wireless connection between the automated banking machine and the portable wireless device, a second message from the portable wireless device representative of a request to perform a transaction with the automated banking machine. Step (d) then recites authorizing the transaction through communication between the banking machine and a remote host system.

In contrast, Gutman describes the opposite flow of communication (Figures 5C - 5E), where the electronic wallet initiates a transaction via the third party, which the Action appears to regard as the remote host system (Column 14, lines 26-27) rather than with the automated banking machine. The third party then subsequently handshakes the information with the financial institution, which the Action appears to regard as the automated banking machine (Column 14, lines 53-54). Thus based on the interpretation of Gutman alleged in the Action, Gutman teaches an opposite flow of communication compared to the method steps recited in claim 1.

Further, even if the Office reverses its argument by alleging that Gutman's third party corresponds to the recited automated banking machine and that Gutman's central financial institution computer corresponds to the remote host system, Applicants respectfully submit that Gutman would still not disclose or suggest the steps recited in claim 1. For example, nowhere does Gutman disclose or suggest that the third party corresponds to an automated banking machine. Further, even if it were possible, which it is not, for the third party to correspond to an automated banking machine, such an interpretation of Gutman would result in Gutman teaching the opposite flow of communication compared to step (e) of claim 1.

Step (e) of Applicants' claim 1 recites sending from the banking machine through the wireless connection to the portable wireless device, an authorization confirmation message. Gutman does not disclose or suggest that the third party send through a wireless connection to the electronic wallet an authorization confirmation message. Rather Gutman teaches that the financial institution sends a confirmation message to the electronic wallet via the communication system (Column 14, lines 62-64).

In addition, step (f) of Applicants' claim 1 recites receiving through the wireless connection from the portable wireless device a commit transaction message. It is respectfully submitted that Gutman does not disclose or suggest a method including such a step. As discussed previously, Gutman discloses that the electronic wallet may receive a confirmation message from the financial institution; however, nowhere does Gutman disclose that the electronic wallet sends a commit transaction message through the wireless connection to either the central financial institution computer, a third party or any other device.

The Action asserts that Applicants' step (f) is shown in Figure 6A, item 612, of Gutman. However Gutman discloses that item 612 involves the confirmation message received by the electronic wallet (Column 17, lines 31-37) from the central financial institution computer, not a commit transaction sent by the electronic wallet to an automated banking machine.

Gutman does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicants' claim 1 patentably distinguishes over the Gutman reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that the claims which depend from claim 1 are likewise allowable.

Claim 2

Amended claim 2 depends from claim 1 and further recites receiving with the banking machine from the portable wireless device through the wireless connection, at least one identification value and data corresponding to at least one financial account. Claim 2 further recites that step (d) includes sending data corresponding to the at least one identification value and the at least one financial account to a remote host system.

Gutman does not disclose or suggest a banking machine that receives an identification value or financial account data from a portable wireless device through a wireless connection. Further, Gutman does not disclose a banking machine that sends data corresponding to an identification value and a financial account received from a portable wireless device, to a remote host system. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 2 is further allowable on this basis.

Claim 4

Claim 4 depends from claim 2 and further recites that the at least one identification value corresponds to a digital certificate. Gutman does not disclose or suggest that at least one identification value received with a banking machine through a wireless connection from a portable wireless device, corresponds to a digital certificate. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 4 is further allowable on this basis.

Claim 5

Claim 5 depends from claim 2 and further recites that the at least one identification value corresponds to a PIN. Gutman does not disclose or suggest that at least one identification value received by a banking machine through a wireless connection from a portable wireless device corresponds to PIN. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 5 is further allowable on this basis.

Claim 8

Claim 8 depends from claim 1 and further recites that the portable wireless device comprises at least one data store including data representative of monetary value. Claim 8 further recites modifying the data representative of monetary value responsive to at least one message communicated with the banking machine through the wireless connection.

Gutman does not disclose or suggest modifying data representative of monetary value in a data store of a portable wireless device responsive to at least one message communicated with a banking machine through a wireless connection. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 8 is further allowable on this basis.

Claim 9

Claim 9 depends from claim 1 and further recites that the wireless connection comprises an RF connection. Gutman does not disclose or suggest a wireless connection between an automated banking machine and a portable wireless device which comprises an RF connection. As nothing in the applied art discloses or suggests this feature, it is respectfully submitted that claim 9 is further allowable on this basis.

The Features Recited in Applicants' Claims Patentably Distinguish Over Waller

In the Action claims 16 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Waller.

These rejections are respectfully traversed. As indicated previously, Waller is not prior art with respect to the present application. Nevertheless, even if it were somehow possible for Waller to constitute prior art, it still would not anticipate the claims. Applicant's claims recite features and relationships which are neither disclosed nor suggested by Waller. Further, there is no teaching, suggestion or motivation cited so as to produce Applicants' invention. It is therefore respectfully submitted that Applicants' claims patentably distinguish over the applied references.

**The Pending Claims Are Not Obvious Over
Gutman in view of Waller; or Waller in View of Gutman; or Waller alone**

In the Action claims 3, 6-7, 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gutman in view of Waller. Further in the Action, claims 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waller in view of Gutman. In addition claims 23-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waller alone.

These rejections are respectfully traversed. As previously discussed, Waller does not constitute prior art. Applicants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references" (MPEP § 715.02). Therefore, the rejections involving the Waller reference are not valid. All of the 35 U.S.C. § 103(a) rejections involve Waller.

Furthermore, even if it were somehow possible for Waller to constitute prior art,

Applicants respectfully submit that the Action still would not factually support any *prima facie* conclusion of obviousness. Neither Gutman in view of Waller; Waller in view of Gutman; nor Waller alone, discloses or suggests the features, relationships, and steps that are specifically recited in the claims. Nor is there any teaching, suggestion, or motivation cited for combining features of these references so as to produce the claimed invention. It would not have been obvious to one having ordinary skill in the art to have modified Waller and Gutman alone or in combination to have produced the claimed invention.

For these reasons it is respectfully submitted that the 35 U.S.C. § 103 rejections should be withdrawn.

The New Claims

None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claim 28-35. These claims recite features, relationships and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

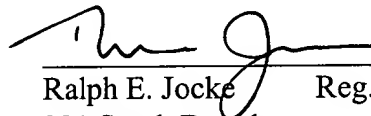
Please charge the fees associated with prosecution of two additional independent claims in excess of 3 (\$168) and eight additional total claims (\$144) and any other fee due, to Deposit Account No. 09-0428 of Interbold.

Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
231 South Broadway
Medina, Ohio 44256
(330) 722-5143